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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,971	12/06/2001	David Green	22728-06523	2745
758	7590	01/27/2005	<div>EXAMINER</div> <div>TRAN, THAI Q</div>	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			<div>ART UNIT</div> <div>2616</div>	<div>PAPER NUMBER</div>

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/006,971	GREEN, DAVID	
	Examiner	Art Unit	
	Thai Tran	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 9,20,22,42,43,46,49,50,53,54,63,65,66,72,82,84-86,111,120 and 130-133 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims allowed are 1-8,10-19,21,23-41,44,45,47,48,51,52,55-62,64,67-71,73-81,83,87-110,112-119,121-129 and 134-138.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sept. 7, 2004 has been entered.

Response to Arguments

2. Applicant's arguments filed Sept. 7, 2004 have been fully considered but they are not persuasive.

In re pages 21-25, applicant argues that Gurner is not relevant prior art under 35 USC 102(e) because Gurner has a filing and priority date of January 6, 1997 and the present reissue application can claim priority to U.S. Patent Application serial number 08/399,013 filed March 6, 1995 ("Parent Application"), which is almost two years earlier than Gurner's filing date and the claimed subject matter is supported throughout the specification of the Parent Application.

In response, after careful consideration of the parent application 08/399,013, the claimed limitations "wherein the first video source comprises one from a group consisting of a videotape, a video disk, a DVD, a Compact Disc, an optical storage medium, a solid state storage medium, and a magnetic storage medium" of claims 9, 20, 46, 54, 65, 72, 84, 111, 120, and 131 ; "wherein the first video signal comprises one form a group consisting of a composite video signal, an S-video signal, a digital video

Art Unit: 2616

signal, and an optical digital video signal" of claims 22, 66, 86, and 133; "wherein the keying the identified portion of the first video signal step further comprises the step of saturating a pre-determined color of the identified portion of the first video signal" of claim 42; "wherein the keying the identified portion of the first video signal step further comprises the step of altering a luminance level of the identified portion of the first video signal" of claim 43; "transmitting the captured and keys first video signal over one from a group consisting of a communication network, a cable television network, and a satellite television network" of claim 49; "wherein the first video signal comprises one from a group consisting of educational video content, entertainment video content, and athletic video content" of claim 50; and "wherein the external device comprises one from a group consisting of a video monitor, a projection device, and a television" of claims 53, 63, 82, 85, 130, and 132. Since, as discussed above, some of the limitations as claimed are not supported by the parent application 08/399,013, the above identified claims can be rejected under Gurner alone or in combination with other references as set forth in the last Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2616

4. Claims 20, 22, 42, 43, 49, 50, 53, 63, 65, 66, 82, 84, 85, 86, 130, 131, 132, and 133 are rejected under 35 U.S.C. 102(e) as being anticipated by Gurner et al ('537) as set forth in the last Office Action.

Regarding claim 20, Gurner et al discloses an apparatus (Fig. 1) configured to combine video signals from a plurality of video sources, comprising an input (source 12 video camera 12 of Fig. 1, col. 5, lines 51-59, col. 6, lines 50-58, col. 5, line 60 to col. 6, line 18, col. 6, lines 59-67, and col. 8, lines 27-42) configured to receive a first video signal from a pre-recorded video source and configured to receive a second video signal from a second video source, the first video signal defining a foreground and including pre-keyed background portions; a mixer (mixer 16 and audio mixer 34 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 27-42) coupled with the input and configured to replace the identified pre-keyed background portions of the first video source with the second video signal to generate a synchronized video signal; an output (video monitor 18 and speaker 36 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 43-48) coupled with the mixer and configured to provide the synchronized video signal to an output device; and wherein the output device comprises one from a group consisting of a videotape, a video disk, a DVD, a Compact Disc, an optical storage medium, a solid state storage medium, and a magnetic storage medium (col. 7, lines 50-52).

Regarding claim 22, Gurner et al discloses the claimed wherein the first video signal comprises one from a group consisting of a composite video signal, an S-video signal, a digital video signal, and an optical digital video signal (col. 6, lines 50-58).

Regarding claim 42, Gurner et al discloses a method of producing a video recording having a first video signal for use with mixing another video signal (Fig. 1) the method comprising:

capturing on a storage medium the first video signal from a first video source (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67);

identifying a portion of the video signal for later overlay by a portion of an unkeyed second video signal from a second video source (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67);

keying the identified portion of the first video signal (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67);

recording the captured and keyed first video signal on a recording medium (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67); and

wherein the keying the identified portion of the first video signal step further comprises the step of altering a luminance level of the identified portion of the first video signal (col. 6, lines 6-17).

Regarding claim 43, Gurner et al discloses the claimed wherein the keying the identified portion of the first video signal step further comprises the step of altering a luminance level of the identified portion of the first video signal (col. 6, lines 6-17).

Regarding claim 49, Gurner et al discloses the claimed transmitting the captured and keyed first video signal over one from a group comprising a communication network, a cable television network, and a satellite television network (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67).

Regarding claim 50, Gurner et al disclosed the claimed wherein the first video signal comprises one from a group consisting of educational video content, entertainment video content, and athletic video content (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67).

Regarding claim 53, Gurner et al discloses a video playback device (Fig. 1) configured to provide video signals comprising a portion of a first video signal and a portion of a second video signal, the video playback device comprising a playback mechanism (source 12 of Fig. 1, col. 5, lines 51-59, col. 6, lines 50-58, and col. 8, lines 27-42) configured to play a pre-recorded video medium, the pre-recorded medium further comprising a pre-recorded video signal including a pre-keyed portion; a mixer (mixer 16 and audio mixer 34 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 27-42) coupled with the playback mechanism and configured to identify the pre-keyed portion of the pre-recorded video signal and configured to receive a second video signal from a video source, and configure to replace either the pre-keyed portion or a non-pre-keyed portion of the pre-recorded video signal with the second video signal to generate an output video signal; and wherein the external device comprises one from a group consisting of a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 63, Gurner et al discloses the claimed wherein the mixer further comprises a switcher configured to detect the pre-keyed portions of the pre-recorded video signal (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67); wherein the pre-recorded video signal further comprises a prompting channel (col. 5, line 60 to col. 6, line 18, and col. 6, lines 59-67); wherein the mixer extracts control signals from the

Art Unit: 2616

prompting channel for controlling an external device coupled with the mixer (col. 9, line 14 to col. 10, line 24); and wherein the external device comprises one from a group comprising a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 65, Gurner et al discloses the claimed an external portion configured to couple with an external device for transmitting the output video signal (col. 7, lines 26-32) and wherein the external portion couples with one from a group consisting of a video tape playback device, a video disk playback device, a Compact Disc playback device, a DVD playback device, a solid state storage device, an optical storage device, and a magnetic storage device (col. 7, lines 50-52).

Regarding claim 66, Gurner et al discloses the claimed wherein the pre-recorded video signal comprises one from a group consisting of a composite video signal, an S-video signal, a digital video signal, and an optical digital video signal (col. 6, lines 50-58).

Regarding claim 82, Gurner et al discloses an apparatus (Fig. 1) configured to combine video signals from a plurality of video sources, comprising an input (source 12 of Fig. 1, col. 5, lines 51-59, col. 6, lines 50-58, and col. 8, lines 27-42) configured to receive a first video signal from a pre-recorded video source and configured to receive a second video signal from a second video source, the first video signal including a keyed portion and a non-keyed portion; a mixer (mixer 16 and audio mixer 34 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 27-42) coupled with the input and configured to replace either the keyed portion or the non-keyed portion with the second video signal to generate a synchronized video signal; an output (video monitor 18 and speaker 36 of

Art Unit: 2616

Fig. 1, col. 5, lines 51-59 and col. 8, lines 43-48) coupled with the mixed and configured to provide the synchronized video signal for an output device; wherein the first video signal further comprises a prompting channel (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67); wherein the mixer extracts the control from the prompting channel for controlling an external device coupled with the mixer (col. 9, line 14 to col. 10, line 24); and wherein the external device comprises one from a group consisting of a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 84, Gurner et al discloses the claimed wherein the output device comprises one from a group consisting of a videotape device, a video disk device, a DVD device, a Compact Disc device, an optical storage device, a solid state storage device, and a magnetic storage device (col. 7, lines 50-52).

Regarding claim 85, Gurner et al discloses the claimed wherein the output device comprises one from a group consisting a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 86, Gurner et al discloses the claimed wherein the first video signal comprises one from a group consisting of a composite video signal, an S-video signal, a digital video signal, and an optical digital video signal (col. 6, lines 50-58).

Regarding claim 130, Gurner et al discloses an apparatus (Fig. 1) configured to generate a synchronized video signal from a plurality of video signals, comprising:

an input means (source 12 of Fig. 1, col. 5, lines 51-59, col. 6, lines 50-58, and col. 8, lines 27-42) for receiving a first video signal from a means for storing and for receiving a second video signal from a means for capturing video, the first video signal

Art Unit: 2616

including a keyed portion and a non-keyed portion; a mixing means (mixer 16 and audio mixer 34 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 27-42) coupled with the input means for replacing either the keyed portion or the non-keyed portion with the second video signal for generating a synchronized video signal; an output means (video monitor 18 and speaker 36 of Fig. 1, col. 5, lines 51-59 and col. 8, lines 43-48) coupled with the mixing means for outputting the synchronized video signal to an output device; wherein the first video signal further comprises a prompting channel (col. 5, line 60 to col. 6, line 18 and col. 6, lines 59-67); wherein the means for mixing further comprises a means for extracting the control signals from the prompting channel for controlling an external device (col. 9, line 14 to col. 10, line 24); and wherein the external device comprises one from a group consisting of a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 131, Gurner et al discloses the claimed wherein the output device comprises one from a group consisting of a videotape device, a video disk device, a DVD device, a Compact Disc device, an optical storage device, a solid state storage device, and a magnetic storage device (col. 7, lines 50-52).

Regarding claim 132, Gurner et al discloses the claimed wherein the output device comprises one from a group consisting of a video monitor, a projection device, and a television (col. 7, lines 26-32).

Regarding claim 133, Gurner et al discloses the claimed wherein the first video signal comprises one from a group consisting of a composite video signal, an S-video signal, a digital video signal, and an optical digital video signal (col. 6, lines 50-58).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 46, 54, 72, 111, and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gurner et al ('537) as set forth in the last Office Action.

Regarding claim 9, Gurner et al discloses all the features of the instant invention as discussed above except for that the first video source comprises one from a group consisting of a videotape, a video disk, a DVD, a Compact Disc, an optical storage medium, a solid state storage medium, and a magnetic storage medium.

Gurner et al teaches in col. 6, lines 50-58 that the first video source (source 12) is a storage medium which stores one or more pre-mixed foreground clips. The storage means may be of any type, and may store the clips in any conventional video format. Typically, best results are obtained by employing digital formats, although analogue implementations also fall within the scope of the present invention.

Gurner et al also teaches in col. 7, lines 50-52 that the output media recorder 20 may be any type of video recording apparatus including, but not limited to, a video tape recorder, laser disk system or a digital video disk (DVD) system.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the well known video tape recorder, laser disk system or digital video disk system as taught by Gurner et al for the video source 12 of Gurner et al since

Art Unit: 2616

it merely amounts to selecting an alternative equivalent storage device and because Gurner teaches that the video source 12 can be any type of storage device.

Claim 46 is rejected for the same reasons as discussed in claim 9 above.

Claim 54 is rejected for the same reasons as discussed in claim 9 above.

Claim 72 is rejected for the same reasons as discussed in claim 9 above.

Claim 111 is rejected for the same reasons as discussed in claim 9 above.

Claim 120 is rejected for the same reasons as discussed in claim 9 above.

Allowable Subject Matter

7. Claims 1-8, 10-19, 21, 23-41, 44-45, 47-48, 51-52, 55-62, 64, 67-71, 73-81, 83, 87-110, 112-119, 121-129, and 134-138 are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited reference relates to an apparatus for video merging employing pattern-key insertion.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

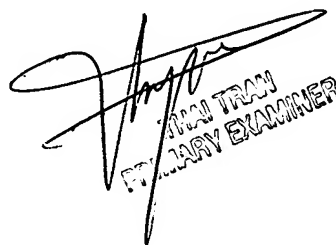
The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



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PRIMARY EXAMINER